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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,470	08/16/2001	James M. Hagberg	108172-00071	6361

4372 7590 12/08/2003

ARENT FOX KINTNER PLOTKIN & KAHN
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER	
SWITZER, JULIET CAROLINE	
ART UNIT	**PAPER NUMBER**
1634	

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/856,470	HAGBERG ET AL.	
	Examiner	Art Unit	
	Juliet C. Switzer	1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *2 and 4*.

   Claim(s) withdrawn from consideration: _____.
8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that the recitation "having a "12" genotype" in claim 2 and having a "11" genotype in claim 4 would be readily understood by one of ordinary skill in the art. Applicant's own arguments in the prosecution history of this application highlight the fact that this language is not clear, as in two different papers, applicant set forth two different definitions for the "12" haplotype. In the previously filed arguments (see paper filed 4/7/03) applicant set forth that "It is further submitted that it would be understood by one of ordinary skill that the "11" genotype would contain Lys at position 153 and that "12" would contain arginine based upon the teachings of page 7, line 1 1 of the present specification," yet in this response applicant sets forth that "12" refers to an AG genotype in terms of nucleotides and a lysine/artinine in terms of amino acids. The specification is silent as to the meaning of these terms. Even if the "12" genotype were established to be referring to a heterozygote (as set forth in present remarks), the specification still does not teach what the "11" genotype refers to. The section of the specificaiton cited by applicant describes a method for genotyping but does not name the possible alleles. Thus, it is maintained that the claims are indefinite because it is not known which alleles are being referred to using the codes "11" and "12." Ths specification simply does not define these arbitrary codes.

With regard to the "extensive exercise" portion of the 112 1st paragraph rejection, applicant points out that the specification discusses a number of possible regimes that are considered "extensive exercise." However, some of these encompass periods of time that are much shorter than the nine months of the example, and there is no evidence in the specification that these shorter periords of time might be associated with improvement. Further, it is noted that applicant's arguments address only a small part of the enablemetn rejection, and even if these overcame the problem with the scope of "extensive exercise" the enblement rejection would still be maintained for the reasons of record.

W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600